

Appl. No.: 10/632,980
Amdt. Dated: __ November 2005
Reply to Office Action mailed 08/12/2005

Remarks/Arguments

Specification

In the Office Action mailed 08/12/2005 the Examiner has required identification of a co-pending application in the specification. Accordingly, applicant has herein requested correction to this application to identify the co-pending application, as well as US Patent No. 6,892,863 that resulted from the co-pending application.

Rejection under doctrine of obviousness-type double patenting

The Examiner has rejected claims 1-20 under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of the aforesaid US Patent No. 6,892,863 in view of Smith '747. The claims in the case have been amended and as amended are believed free of this rejections as discussed below.

The Examiner admits Everett '863 does not include the end cap of applicant's invention and relies on Smith '747 to provide the link that would make applicant's invention obvious. In such reliance the Examiner states the reference of Smith teaches it is old and well known in the art to provide such a removable means or end cap that is secured with pin type connection at 10. The Examiner thus takes the position that Smith teaches that an end cap is old in the art and it would be obvious to take the end plate 9 of Smith and then modify the teachings of the '863 patent with the end plate 9 to result in applicant's claimed end cap. The Examiner is in error in taking this position for at least the following reasons:

Everett does not teach or suggest an end cap of any kind;

Smith does not teach or suggest an end cap of any kind much less that applicant's end cap is old and known in the art. Smith merely teaches a flat planar rectangular end plate 9 that only provides a keyed barrier for the brake pads within the holder; and

None of the prior art teaches the end cap of the applicant to be old in the art, or to even suggest an end cap as taught and claimed in the present invention;

It is thus immediately obvious that combining the Smith end plate 9 with the teachings of Everett '863 would have no resemblance to the end cap of the presently claimed invention. It would be too much of a stretch of the imagination for one skilled in the art to modify the end plate 9 of Smith to result in applicants taught and claimed end cap.

It is well known [Hodosh v. Block_Drug Co., Inc." (Fed. Cir. 1986) 229 USPQ 182] that:

1) the claimed invention must be considered as a whole... (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art);

(2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination .. ;

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention .. ;

It is submitted that (1) the Examiner has not considered the claimed invention as a whole but has merely seized upon the similarities in Everett '863 and combined them with the totally inapplicable end plate 9 of Smith in the attempt to show obviousness; (2) the references were not properly considered since neither suggested the desirability and thus the obviousness of making a combination as put forth by the Examiner; and (3) the Examiner has doubtlessly viewed the references with the benefit of hindsight afforded by the present invention since no other reference teaches or suggests applicant's end cap. Accordingly, the applicant respectfully traverses the double patenting rejection in view of the above discussion and in view of applicant's claims as amended herein.

Rejections under 35 U.S.C. 103(a)

The Examiner has rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Irvine '973 in view of Everett '959 and Smith '749 or Penny '891. Claims 1-6 and 8-20 have been amended either directly or indirectly and claim 7 has been canceled. As presently presented it is submitted that the claims remaining in the case are free of this rejection in accordance with the following discussion.

The Examiner admits there is a lack of showing in Irvine of multiple brake pads having different braking compounds in sequential abutting relationship as well as closure means, but has stated that Irvine shows in figure 3 a brake pad "similar" to applicant's pad holder. Giving Irvine's disclosure of the benefit of the doubt and fully considering holder 28 and pad 12, similarity is not grounds for rejection and there is no teaching or suggestion in Irvine of the truncated open end brake pad holder and mating end cap as taught and claimed by applicant.

Everett '959 is relied upon by the Examiner merely to show brake pads having different compounds for desired breaking and wear characteristics. This is the only similarity with the present invention with no teaching or suggestion in Everett '959 that this reference could be combined with the other cited references to show applicant's invention.

Smith is relied upon to show it is known in the art to make a brake pad or shoe from multiple parts. However, the similarity ends at that point since there is no teaching or suggestion in this reference that it could somehow be combined with the other cited references to show applicant's invention. The Examiner also calls attention to closure means at 9 and 10, however, these elements merely disclose a flat rectangular plate 9 used as a brake pad barrier or holder having a hole therein to accept a pin 10 to thus lock the barrier in place. This is a simple rudimentary concept that has no bearing on the combination truncated holder end and mating end cap of applicant.

Penny is relied upon for a teaching similar to Smith with attention called to the closure means in the area of "c" and "f". Element "c" is a recess for inserting brake pads of wood "B" into the pad holder with "f" a rod or bolt for retaining the pads within the pad holder. It is seen that in Penny there also is no teaching of, suggestion of, or motivation for, (1) multiple pads of

different elastomers having different braking characteristics, (2) pads that slide in the brake shoe in a direction parallel to the contact axis or surface plane, (3) a brake shoe having a planar contact surface but longitudinally curve in conformance with the curvature of the sidewall of the bicycle tire, and (4) a brake shoe having pads applied to the sidewall of the bicycle tire. Thus, in no way does Penney teach or suggests applicant's claim of invention.

Thus, what results from the Examiner's position primarily is:
the straight (no transverse longitudinal curvature) open ended similar brake pad holder of Irvine;
the single brake pad of Everett '959 having partitions of different compounds and breaking characteristics;
the multiple breaking blocks of wood of Smith or Penney with their primitive pad barrier closure means.

In what appears to be the best combined scenario, even though there is no suggestion in the references that they could be combined, is the straight holder of Irvine with multiple brake pads of different compounds and breaking characteristics of Everett constrained in the holder with the flat rectangular plate as shown by Smith. It is thus obvious that the combination of references as suggested by the Examiner would not result in applicant's claimed invention nor include teachings to make applicant's invention obvious therefrom. There is no nexus in the combination of the references that their teachings would be capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure. Conversely, it is submitted that the conclusions reached by the Examiner in relating the references to show the applicants' invention to be obvious speculation and hindsight, not to mention an erroneous piecemeal application of the references. This is seen to be especially evident considering applicant's now claimed end cap which is not disclosed in the prior art.

Summary

The claims remaining in the case, that is, claims 1-6 and 8-20, have been amended, directly or indirectly, in accordance with the above discussion. Claim 7 has been canceled. It is respectfully requested that the Examiner's rejections be reconsidered, the claims allowed, and the case passed to issue.

It is hereby certified that this Amendment is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on // November 2005.

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Respectively submitted,



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